

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.=S DOCKET: TANGA2

In re Application of:) Art Unit: 1655
Michifumi TANGA, et al.)
Serial No.: 09/601,875) Examiner: B.J. FORMAN
Filed: October 12, 2000) Confirmation No. 5274
For: SUBSTRATES AND CHIPS) Washington D.C.
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RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
Washington, D.C. 20231

The Office Action of December 12, 2001, in the nature of a requirement for restriction, has been carefully reviewed. Favorable consideration is respectfully requested.

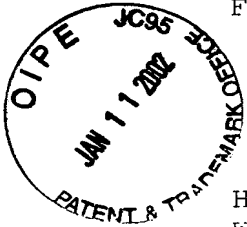
Restriction has been required between what the Examiner considers to be two patentably distinct inventions, namely,

Group I directed to a substrate, presently comprising claims 1-11, 13-16, and 22-25; and

Group II, drawn to a method for immobilizing and amplifying DNA, presently comprising claims 12 and 26-38.

Applicants hereby provisionally elect, with traverse and without prejudice, claims 1-11, 13-16, and 22-25, Group I, directed to a substrate.

This restriction requirement is traversed on the basis of MPEP Section 803, second paragraph, which requires that there be a substantial burden in examining plural groups, even if the restriction requirement is otherwise



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correct. The present application is an RCE of an application which had been previously examined, albeit by a different examiner. However, claim 12, has already been examined. Because of this, it is respectfully submitted that there would be no substantial burden on the present examiner to examine the claims in Group II along with the claims in Group I, as the present application is a request for continued examination, not for an initial examination. Since there appears to be no substantial burden, the restriction requirement should be withdrawn, and such is respectfully requested.

If the restriction requirement is maintained, it will be clear on the record that the PTO considers the two groups to be patentably distinct from one another i.e., *prima facie* non-obvious from one another. This means that a reference identical to the one group would not render the other group *prima facie* obvious.

Favorable consideration is respectfully requested.

Respectfully submitted,

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